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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,642	09/09/2003	Lawrence J. Longobardi	11342.3.1	4771

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EXAMINER	
HAMDAN, WASSEEM H	
ART UNIT	**PAPER NUMBER**
2854	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/658,642	LONGOBARDI, LAWRENCE J.	
	Examiner	Art Unit	
	Wasseem H. Hamdan	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/9/03, & telephone interview on 8/30/05*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *12-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *01/30/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-11, drawn to a method for creating an original work of art, classified in class 101, subclass 483.

   II. Claims 12-20, drawn to an original work of art, classified in class 428, subclass 156.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed in Group II can be made by another and materially different process without the specifics of the Group I process i.e. programming a computerized color printer with a computer program to generate a color print layer etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Neil Nydegger and examiner Catherine Simone on 8/30/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-20 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/935,820. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations claimed in the instant application are claimed in the copending Application No. 10/935,820.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Francini (US patent 6,801,303 B2).

Regarding claim 1, Francini discloses a method for creating an original work of art [column 1, lines 41-43], which comprises the steps of:

programming a computerized color printer [column 2, line 1 (it is inherent that the printer is programmed, since the printer is considered a passive device)] with a computer ; program to generate a color print layer [column 2, line 5; column 3, lines 43-44];

providing a base substrate having a surface [2];

applying a relief layer [3] onto the surface of the substrate [2] wherein the relief layer includes deposits of viscous ink [column 3, lines 3-6];

configuring the deposits of viscous ink of the relief layer in dimension and arrangement to create textural and tonal contrasts for the work of art [since layer 3 interacts with the ink of coat 2 and the substrate 1, the visual effect results in a relief layer of dimension and arrangement that creates textural and tonal contrasts for the work of art]; and

using the color printer to apply the color print layer to the substrate over the relief layer [column 3, lines 20-25], to incorporate the deposits of viscous ink in the relief layer into the color print layer for a combined presentation thereof in the work of art Fig. 2; Fig. 3].

Regarding claim 10, Francini discloses the step of employing the computer program to register the color print layer with the relief layer [Fig. 3].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francini (US patent 6,801,303 B2) in view of Longobardi (US Patent 4,933,218).

Regarding claim 2, Francini discloses the essential elements of the claimed invention but Francini is silent about the applying step including screen printing. Longobardi, discloses an applying step including screen printing [column 3, lines 28-29]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by using screen printing, since screen printing allows the operator to easily apply viscous inks.

Francini discloses the essential elements of the claimed invention but Francini is silent about the substrate being clear. Longobardi discloses a clear substrate [12; column 2, lines 52-

53]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including a clear substrate, since Longobardi teaches that having a clear substrate would be beneficial for the purpose of permitting the passage of selected light.

Regarding claim 3, Francini discloses wherein the configuring step is accomplished manually [column 1, line 17].

Regarding claim 4, Francini discloses the step of creating a plurality of original works of ad by selectively reconfiguring the relief layer for each original work of art [column 3, lines 40-45, since Francini discloses creating reliefs 3 which initiate corresponding ones of art to be copied].

Regarding claim 5, Francini discloses the essential elements of the claimed invention but is silent about wherein the applying step is accomplished by screen printing the relief layer directly onto the surface of the substrate. Longobardi, discloses wherein the applying step is accomplished by screen printing the relief layer directly onto the surface of the substrate [column 3, lines 28-29]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including wherein the applying step is accomplished by screen printing the relief layer directly onto the surface of the substrate, since screen printing allows the operator to easily apply viscous inks.

Regarding claim 6, Francini discloses the essential elements of the claimed invention but Francini is silent about wherein the ink deposits are made with a clear viscous ink. Longobardi, discloses wherein the ink deposits are made with a clear viscous ink [column 3, lines 12-13]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including wherein the ink deposits are made with a clear viscous ink, since having wherein the ink deposits are made with a clear viscous ink would be beneficial for the purpose of permitting the passage of selected light.

8. Claims 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francini (US patent 6,801,303 B2) in view of Longobardi (US Patent 5,106,126).

Regarding claim 7, Francini discloses the essential elements of the claimed invention but is silent about wherein the surface of the base substrate is reflective and said method further comprises the step of incorporating a white layer between the reflective surface of the substrate and the relief layer to provide opacity to diminish the reflectivity of selected portions of the reflective surface. Longobardi, discloses wherein the surface of the base substrate is reflective and said method further comprises the step of incorporating a white layer [32] between the reflective surface of the substrate [12] and the relief layer [30] to provide opacity to diminish the reflectivity of selected portions of the reflective surface [FIG. 3]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including wherein the surface of the base substrate is reflective and said method further comprises the step of incorporating a white layer between the reflective surface of the substrate and the relief layer to provide opacity to diminish the reflectivity of selected

portions of the reflective surface, since having wherein the surface of the base substrate is reflective and said method further comprises the step of incorporating a white layer between the reflective surface of the substrate and the relief layer to provide opacity to diminish the reflectivity of selected portions of the reflective surface would be beneficial for the purpose of blocking the passage of light to reflective layer [longobardi et al. column 4, lines 16-18].

Regarding claim 8, Francini discloses the essential elements of the claimed invention but Francini is silent about wherein the incorporating step comprises screens printing white ink placed onto selected portions of a clear substrate; and bonding the clear substrate with white ink thereon to the surface of the substrate. Longobardi discloses wherein the incorporating step comprises screen printing [column 1, line 33] white ink placed onto selected portions of a clear substrate [column 4, lines 13-29; FIG. 1; FIG. 3]; and bonding the clear substrate with white ink thereon to the surface of the substrate [FIG. 3]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including wherein the incorporating step comprises screen printing white ink placed onto selected portions of a clear substrate; and bonding the clear substrate with white ink thereon to the surface of the substrate, since having the above limitations would be beneficial for the purpose of blocking the passage of light to reflective layer.

Regarding claim 9, Francini discloses the essential elements of the claimed invention but Francini is silent about the step of creating a plurality of original works of art by selectively reconfiguring the white ink for each original work of art. Longobardi, discloses the step of

creating a plurality of original works of art by selectively reconfiguring the white ink for each original work of art [column 4, lines 60-67; Fig. 5 (40); deposit white ink over preselected portion of ink layers, is the same as reconfiguring the white ink for each original work of art. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including the step of creating a plurality of original works of art by selectively reconfiguring the white ink for each original work of art, since having the above limitations would be beneficial for the purpose of reproducing different art work.

Regarding claim 11, Francini discloses the essential elements of the claimed invention but Francini is silent about the color print layer comprises a plurality of variously colored ink dots. Longobardi discloses the color print layer comprises a plurality of variously colored ink dots [column 2, lines 44-46; FIG. 2]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Francini by including the color print layer comprises a plurality of variously colored ink dots, since Longobardi teaches that having the color print layer comprises a plurality of variously colored ink dots would be beneficial for the purpose of forming the desired colored image [Longobardi: column 2, lines 9-14].

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H. Hamdan whose telephone number is (571) 272-2166. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wasseem H. Hamdan

September 1, 2005

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